

REMARKS

This is in response to the office action dated July 15, 2011, which rejected all pending claims as unpatentable over one or more references under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a). This response is believed to address the grounds for rejection and place the application in a condition for further examination.

Interview with the Examiner

On or about September 20, 2011, Applicants had a telephone interview with the Examiner to discuss some references cited in this and other related cases. A brief second telephone interview took place on or about September 27, 2011. Applicants thank Examiner Lanier for courtesies shown. No agreement was reached in the interview as to the interpretation or allowance of any claims.

Finality of Office Action

During the Interview Applicants discussed the indication that the first office action (after the filing of an RCE) was “final.” Examiner Lanier indicated that this was an error. Applicants respectfully request the Examiner to withdraw finality of the office action and permit a second office action on the merits.

Amendments to the Claims

Claim 44 is amended to clarify that the information object is included in the first user’s account. The prior version of this claim recited “the first online repository” which had no antecedent basis. It should have been --the first user’s online repository--. However, as the user’s account was recited in the preamble, it is believed that the correct recitation should have been --the first user’s account--. Applicants regret this error. No new matter is added as a result of this amendment. Examiner is respectfully requested to review and enter the amendment.

Examiner's Implicit Official Notice regarding whether "video" information was disclosed in the parent application

Examiner appears to argue that the disclosure of 09/478,796, filed January 7, 2000 had insufficient disclosure of usage of "video" information in the online repository. However, because the term "video" is recited in the Specification, it is believed that Examiner might have taken some form of implicit Official Notice that the disclosure of Ser. No. 09/478,796 at page 10 did not have sufficient indicia of "video" information objects.

But it is respectfully submitted that at Page 10, lines 15-16 the Specification discloses "biometric information (retina scan, samples of speech, finger prints, DNA sequences, and other information)" The term "biometric" includes video information. See, e.g., USP 6,181,803 (Filed 1996) to Davis entitled "Apparatus and method for securely processing biometric information to control access to a node", at Col. 2, lines 26-31 ("video camera used for biometric authentication * * * is continuously capturing * * * data clips (video images) * * * *") and Col. 4, lines 36-52 (describing video cameras used as biometric information sensing devices). Based on this it is submitted that the term "biometric information" in the Specification is sufficient to disclose the existence of information in a "video" form.

Applicants did not limit the term "information" to exclude "video"; in fact, as stated in earlier responses to office actions, the Specification a page 20, line 16 discloses that information comprises "voice, video, data and/or text or any combinations thereof." Given these illustrations, therefore, Examiner is respectfully requested to point out how the inference that "video" was not disclosed in the Specification, which inference appears to be not grounded in fact and in the nature of an unstated "official notice". Reconsideration is respectfully requested.

Rejection of Claim 38 under 35 U.S.C. § 102(e) over Meyer

The office action rejected claim 38 as being unpatentable over Meyer (US Publication No. 2001/00310066). Initially, it is noted that Meyer is antedated by the parent application Ser. No. 09/478,796 to which this application claims priority for subject matter disclosed in the parent application. Meyer is inapposite because every element of Meyer that is cited as anticipating is also in the parent application Ser. No. 09/478,796 filed before Meyer was filed. For example, the notion that information objects could be copyrighted is in the parent application at page 18, line 20. Because the parent application contains all the elements of Claim 38 (sans “streaming”), Meyer cannot be used to argue that each of the elements is anticipated by Meyer. To argue that Meyer can anticipate things that were disclosed in a related application to which priority is claimed in this application does not appear to be legally correct. Reconsideration is respectfully requested.

To anticipate, every element and feature of the claim must be found in a single prior art reference, arranged as in the claim. *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). “[A]bsence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986). In addition, an anticipating reference must arrange the elements as in the claim. “[T]he hallmark of anticipation is prior invention, the prior art reference – in order to anticipate under 35 U.S.C. §102 – must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’ [Citation omitted.]” *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008). “[A]n anticipatory reference [must] show all of the limitations of the claims arranged or combined in the same way as recited in the claims, not merely in a particular order. The test is thus more accurately understood to mean ‘arranged or combined in

the same way as in the claim.” *Id.* at 1370.

Additionally, an anticipating reference must be clear and unambiguous to one of ordinary skill in the art. See *Application of Turlay*, 304 F.2d 893, 899 (C.C.P.A. 1962) (“In order to anticipate, the teaching of a reference must be clear and unambiguous.”) An anticipating reference “must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention.” *Crown Operations Int’l, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1375 (Fed. Cir. 2002) (citations omitted). “A document so obscure in its terminology that two conflicting theories may be deduced therefrom and supported by equally plausible arguments is too indefinite to be utilized as an anticipation.” *Cimiotti Unhairing Co. v. Comstock Unhairing Co.*, 115 F. 524 (C.C. 1902)).

Meyer does not arrange all the elements as in claim 38. Further, Meyer is vague, ambiguous and confusing and thus is not proper reference. Finally, Meyer uses the term “content” or “title” in different ways than those terms are used in the Office Action.

The Office Action relies on Meyer at [0030], [0057] & [0073] for the proposition that license information may be stored in association with a copyrighted information object, but Meyer does not state thusly. Claim 38 depends from Claim 32, which recites,

a security module capable of making the one or more copyright-protected information objects accessible to the second party in accord with one or more constraints imposed by respective license information associated with the one or more copyright-protected information objects.

This element is missing from Meyer.

Meyer at Paragraph [0030] describes that a “licensing server” may “download software

players and new music offerings compatible with those players. * * * provide software for decrypting, decoding, and playing electronically distributed music according to usage rules packaged with the electronically distributed music."

At Paragraph [0057], Meyer discloses an "embedding clearing house" which offers "an identifier embedding services". Meyer states that this "embedding clearing house" is an "Internet server accessible via a web page using conventional network communication and web protocols" and "provides an embedding service to embed an identifier into a media object uploaded from the user via the user's computer and Internet connection." This information is either "generic identifying information (e.g., title, author, owner), generic licensing information or special information or actions." According to Meyer, "special purpose information or actions" include "redirect to a web page of the content owner, download related content, provide electronic licensing services, etc."

At Paragraph [0073] Meyer states that there could exist a server for "establishing a license to use a linked media object."

The differences between the instant claims and the Meyer reference are significant. The rejection is believed to be in error because the reference as a whole does not support the reasoning of the examiner. For the foregoing reasons, Meyer is not a valid reference under 35 U.S.C. § 102(e).

Rejection of Claims 26-27 under 35 U.S.C. § 103 over Meyer in view of Atkinson

The office action rejected claims 26-27 as being unpatentable over Meyer in view of Atkinson. Applicants incorporate by reference the arguments above that Meyer is not a correct reference. Relying on *In re Oetiker*, 977 F.2d 1443, (Fed Cir. 1992), the Office Action states that Atkinson is pertinent reference to or person of ordinary skill in the art facing the problem of

"use of expirations for content licenses." Office Action at page 3, Paragraph 7. However, *Oetiker* says more than what is quoted in the Office Action. In *Oetiker*, the examiner looked to fasteners for garments in order to solve the problem of fastening a hose clamp. Reversing the Examiner's rejection, the Federal Circuit stated:

It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.

Id at 1447. Even though the Supreme Court *KSR v. Teleflex*, rejected a "rigid" application of the TSM test (Teaching, Suggestion or Motivation), Examiner must still show some reason for combining references. See *Unigene Laboratories, Inc. v. Apotex, Inc.* __ F.3d __ (Fed. Cir. August 25, 2011) ("Obviousness requires more than a mere showing that the prior art includes separate references covering each separate limitation in a claim under examination. Rather, obviousness requires the additional showing that a person of ordinary skill at the time of the invention would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention.") Otherwise, every invention being more or less a combination of known elements adapted specially to different uses, no invention can be approved.

In the present case, Examiner states that the problem of restricting licenses is the reason one would have looked to Atkinson. But that is hindsight reasoning because Atkinson is not about restricting licenses. Atkinson is about embedding certification of an executable file in order to ensure its authenticity. See Atkinson at Paragraphs [0010] & [0011].

Accordingly, it appears an error to characterize Atkinson as a source for a person of skill

in the art to look for solution for the problem of "use of expirations for content licenses". See *In re Deminski*, 796 F.2d 436, 443 (Fed. Cir. 1986)("The only way the board could have arrived at its conclusion was through hindsight analysis by reading into the art [applicant's] own teachings. Hindsight analysis is clearly improper, since the statutory test is whether "the subject matter as a whole would have been obvious at the time the invention was made.") (citation omitted). Applicants submit that Examiner has the initial burden of showing obviousness before shifting the burden to the Applicants to show evidence of nonobviousness. See *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Reconsideration is respectfully requested.

The Office Action's reliance on Atkinson at Col. 9, lines 60-61 appears to be in error because Atkinson states as follows:

Publisher license expiration date 128 (FIG. 4) and agency license expiration date 196 (FIG. 8) provide respective digital certificates 122 and 190 with enhanced security by limiting the periods during which they are valid and therefore susceptible to attempted counterfeiting.

Atkinson, thus, discusses that digital certificates might contain enhanced security by limiting the periods during which they are valid. This disclosure of Atkinson is insufficient to modify Meyer and render obvious the following steps of Claim 26:

receiving license information for the copyright-protected information object, said license information indicating that the license is for access of the information object for a predetermined time (T_{license});
permitting access of the copyright-protected information object in accordance with the time constraint imposed by the license information; and
disabling access to the copyright-protected information object upon expiration of the predetermined time (T_{license})

or the following step of Claim 27 (which depends from Claim 26):

allowing each of the n (where $n \leq N$) requesters to access the information object for a predetermined period of time (T_{access})

Nothing in Atkinson in combination with Meyer renders obvious the cited steps of Claims 26 & 27. Reconsideration is respectfully requested.

Rejection of Claim 28 under 35 U.S.C. § 103 over Meyer in view of Atkinson and in further view of Glassman

The office action rejected claim 28 as being unpatentable under 35 U.S.C. § 103(a) over Meyer in view of Atkinson and in further view of Glassman. Meyer and Atkinson are believed to be not correct references for the reasons stated above. Glassman, which was used in an earlier office action, is believed to be an incorrect reference because Glassman teaches away from any combination of the type attempted in the Office Action. Glassman states:

There are many existing implementations of lock servers. However, they all are subject to one or more of the following undesirable restrictions: each content source has its own, separate, and proprietary lock server;

the user's system already has the content protected from direct access and the client program gets the lock to access the content; acquiring a lock is a complicated action; and/or the set of valid users is limited.

For these reasons, existing lock servers are undesirable on an open network.

A lock server providing an N-user license on an open network should also support the following requirements:

an unrestricted set of potential users; no single administrative domain covers all users;

the users do not need to have a separate user application for each source of content;

access to the content can be easily restricted; and

the content exists on the server and not with the user.

Accordingly, there is a need for a way to provide restricted access to electronic content that works with a wide variety of possible access schemes. Preferably, the solution will allow enforcement of an N-user license for content located on an open network like the Internet.

See Col. 2, lines 2-31. Upon so criticizing and declaring the inadequacy of methods used in other areas such as a library or a corporation using a CD-ROM to distribute licensed copy of an electronic version of a magazine, Glassman set out to invent a new method "for electronic commerce that uses special scrip —called "license scrip"—to provide temporary licenses to consumers accessing content."

See Summary of the Invention, first paragraph. In *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007) the Supreme Court stated, "[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious." A reference that "criticize[s], discredit[s], or otherwise discourage[s] the solution claimed", teaches away from the combination. *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). Based on Glassman's criticism of other known methods, one of ordinary skill in the art, given Glassman reference, would not have taken the path taken by the Applicants. See *In re Gurley*, 27 F.3d 551, 553 (Fed.Cir.1994)("A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant."); *In re Spinnoble*, 405 F.2d 578, 587 (CCPA 1969) (references taken in combination teach away since they would produce a "seemingly inoperative device"); *In re Caldwell*, 319 F.2d 254, 256 (CCPA1963) (reference teaches away if it leaves the impression that the product would not have the property sought by the applicant). References that teach away from a claim cannot be used to establish obviousness of the claim with respect to that element.

Glassman suffers from enablement problems as well. For example, Glassman does not enable the so-called "existing implementations of lock servers". One need to speculate the features of these "lock servers" and thereafter further speculate the method of making such "lock

servers", and later speculate that a person of skill in the art would have been able to use the "lock servers" in precisely the type of "open network" that Glassman says they would not work.

In addition, Glassman does not give enabling details of the "combination of a specialized lock server and a client program." Glassman believed that because each "content source" required its own "separate proprietary lock server," which required Glassman to invent a different mechanism "to provide restricted access to electronic content that works with a variety of possible access schemes."

Under these circumstances, it is not correct to argue that one of ordinary skill in the art would have used Glassman as a reference for the very methods that Glassman found unsuitable. Therefore it is submitted that Glassman teaches away from the combination as suggested by the Office Action. Reconsideration is respectfully requested.

**Rejection of Claims 24-25, 29-31, 33-34 & 43 under 35 U.S.C. § 103 over Meyer in
view of Glassman**

The arguments presented above about Meyer and Glassman are incorporated by reference. All independent claims antedate Meyer because of the parent application to which priority is claimed. The Office Action denies priority on the grounds that additional elements are added to some of the claims which are present only in a continuing application. However, Meyer, which is antedated by the parent, cannot be an anticipating reference for those aspects of the claims which are present in the parent application. That would lead to strange result as argued in an earlier paper.

Glassman being a reference that teaches away from a combination should not be used to render unpatentable any claims. In addition, the Office Action appears to read too much from the sparse un-enabled description in Glassman used only to set the stage for his "license scrip".

Specifically, as to claims 30-31, the office action states that Meyer disclosed “formatting” as the term was used in the instant application. However, Meyer at the cited portion [0018] discloses a technique known as “ripping,” which is entirely different from formatting the digital item to suit the requirements of a client device. Reconsideration is respectfully requested.

**Rejection of Claims 24-28, 30-37, and 39-44 under 35 U.S.C. § 103 over Manolis in
view of Glassman**

The office action alternatively rejected Claims 24-28, 30-37, and 39-44 under 35 U.S.C. § 103 over Manolis (USP 7,243,079) in view of Glassman. However, as the office action itself acknowledges, Manolis does not disclose that the information objects can be copyrighted or that they are controlled by a license. Glassman cannot be used as a reference because Glassman teaches away from the combination as suggested by the office action. Therefore each of these claims is believed to be patentable over the combinations suggested in the office action.

Reconsideration is respectfully requested.

Conclusion

No fee is believed to be due with this response. Examiner is respectfully requested to review and reconsider the rejections.

Respectfully Submitted,

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